

Remarks

Applicants would like to thank Examiner Arnold for the courtesies extended to Applicants' representatives, Cynthia Bouchez and the undersigned, during our recent telephonic interview of January 24, 2011. During the interview, Applicants' representatives discussed the patentability of the enclosed amended claim set over the cited art. Applicants' representatives distinguished the claimed invention over U.S. 2004/0157745 A1 ("Vermeer"), U.S. 2005/0221991 A1¹ ("Wolf"), U.S. 2005/0214336 A1 ("Turberg"), and U.S. 5,925,182 ("Patel"), references cited in the outstanding 35 U.S.C. § 103(a) rejection, and discussed why the claimed invention is not obvious in view of the cited art. During the interview, Examiner Arnold acknowledged that the patentability of the amended claim set in view of the cited art of record. Additionally, Examiner Arnold generously agreed to consider the enclosed amended claim set without requiring that a Request for Continued Examination (RCE) be filed. Examiner Arnold also generously agreed to consider **US40**, which is cited in a second supplemental IDS that accompanies this reply, and which is discussed in more detail below.

Upon entry of the foregoing amendments, claims 1 and 18-27 are currently pending, with claim 1 being the sole independent claim.

Claims 1 and 22 are sought to be amended. Support for the amendment of claim 1 can be found, *inter alia*, in originally filed claims 1, 18, and 19, and at pages 29-39 of the application as filed. Claim 22 is amended solely to place it in a format that better

¹ U.S. 2005/0221991 A1 is an English language equivalent of International Publication No. WO 03/099005, the German language document, which was originally cited by the Office in the outstanding 35 U.S.C. § 103(a) rejection.

complies with U.S. Patent and Trademark Office rules, and should not be considered an amendment related to patentability.

Claims 26 and 27 are sought to be added. Support for the addition of new claims 26 and 27 can be found, *inter alia*, at pages 29-39 of the application as filed.

Claims 2-9 and 11-17 are sought to be cancelled.

These changes are believed to introduce no new matter, and their entry is respectfully requested.

Based on the above amendments and the following remarks, Applicants respectfully request that the Examiner reconsider the outstanding rejection, and that it be withdrawn.

Rejection under 35 U.S.C. § 103

The rejection of claims 1, 2, 5-9, 15, 17, and 19-25, under 35 U.S.C. § 103(a) as being unpatentable over Vermeer, Wolf, Turberg, and Patel, is respectfully traversed. Claims 2, 5-9, 15, and 17, have been cancelled. Therefore, the rejection as it relates to claims 2, 5-9, 15, and 17, is rendered moot.

The invention encompassed by claim 1, as amended above, is not a predictable variation of the subject matter disclosed in Vermeer, Wolf, Turberg, and Patel, for at least the following reasons. Accordingly, claim 1 is not *prima facie* obviousness over the cited art.

Applicants have surprisingly found that closed penetrants display a better biological activity than the corresponding open penetrants. (Application as filed, page 3,

lines 5-6.) For example, Examples I and II of the captioned application disclose that using closed penetrants in the oil-based suspension formulations, as encompassed by the claimed invention, results in improved properties when compared to the use of the H-terminated alkanol alkoxylates, an open penetrant. (*See id.* at pages 34-37, Examples I-II.) Example III of the captioned application discloses that using closed penetrants in the oil-based suspension formulations as claimed, results in improved properties when compared to the use of other classes of penetrants. (*See id.* at pages 37-39, Example III.) Furthermore, as discussed in more detail below, none of the cited references discloses or provides a reason to use closed penetrants in an oil-based suspension concentrate. For at least these reasons, a person of skill would not have been lead to the claimed invention with any reasonable expectation of success based on the disclosures of the cited references.

Neither Vermeer, Turberg, Wolf, nor Patel, individually or taken together, discloses a *predictable* variation of the claimed invention. First, Vermeer does not describe or suggest an oil-based suspension concentrate comprising, *inter alia*, spirotetramat and/or imidacloprid and at least one closed penetrant chosen from Formula Ie-1 and Ie-2, as recited in claim 1. Rather, Vermeer describes oil-based suspension concentrates containing *open* penetrants—*i.e.*, alkanol alkoxylates with a H-terminal. (*See e.g.*, Vermeer, pages 3-4, paras. [0068]-[110].) Vermeer does not disclose or provide a reason to use closed penetrants, *i.e.*, alkanol alkoxylates that lack a H-terminal.

Second, neither Wolf, Turberg nor Patel, individually or taken together, cure the deficiencies of Vermeer. The claimed invention is directed to oil-based suspension concentrates containing spirotetramat and/or imidacloprid and at least one closed

penetrant chosen from Formula 1e-1 and 1e-2. Neither Wolf, Turberg, nor Patel, disclose or provide a reason to use an oil suspension concentrate comprising, *inter alia*, spirotetramat and/or imidacloprid in oil-based suspension concentrates with at least one closed penetrant chosen from Formula 1e-1 and 1e-2, or the advantages of using closed penetrants in oil-based suspension concentrates. Rather, Wolf discloses *aqueous* formulations comprising micro-encapsulated penetrants instead of the oil-based formulations according to claim 1 of the present invention. (See Wolf, page 1.) Further, the formulations disclosed in Wolf require the use of *micro-encapsulated* penetrants while the formulations encompassed by the claimed invention do not. Additionally, Wolf teaches that formulations containing non-micro-encapsulated penetrants are often unstable; and in doing so Wolf teaches away from using *non-micro-encapsulated* closed penetrants in oil-based suspension concentrates.

Further, Turberg teaches formulations of phenyl ketoenol derivatives for *parasite control on animals*, such as livestock. (See Turberg, page 1.) Finally, Patel discloses stable liquid compositions comprising a liquid carrier, an oil-soluble polymer, and a solid particulate. Patel does not disclose or provide a reason to add mineral oil or vegetable oil to oil-based suspension concentrates, as claimed. Thus, a person of ordinary skill in the art would not have been lead to oil-based suspension concentrates containing spirotetramat and/or imidacloprid and at least one closed penetrant chosen from Formula 1e-1 and 1e-2, as required by the claimed invention, in view of the cited references.

In summary, the Office has not established that the claimed invention is a *predictable* variation of the disclosures of Vermeer, Turberg, Wolf, or Patel, individually

or combined. Accordingly, the Office has not established a *prima facie* case of obviousness.

Claims 19-25, depend directly or indirectly, from claim 1 and therefore include every limitation of claim 1. *See* 35 U.S.C. § 112, fourth paragraph. Thus, claims 19-25 are non-obvious for at least the same reasons as claim 1.

Applicants respectfully request that the Office withdraw the foregoing rejection under 35 U.S.C. § 103(a).

Second Supplemental IDS

A second supplemental Information Disclosure Statement (IDS), citing U.S. 2007/0066489 as **US40**, accompanies this Amendment and Reply. As discussed above, document **US40** was brought to the attention of Examiner Arnold during the telephonic interview of January 24, 2011. As discussed during the interview, document **US40** is a continuation-in-part application (CIP) of Vermeer, which is cited in the outstanding rejection under 35 U.S.C. § 103(a). Both Vermeer and **US40** claim priority to International Application PCT/EP02/06323, filed June 10, 2002. Applicants thank Examiner Arnold for considering **US40** at this time.

Conclusion

The foregoing ground rejection have been properly traversed, accommodated, or rendered moot. Applicants therefore respectfully request that the Office reconsider the presently outstanding rejection, and that it be withdrawn. Applicants believe that a full and complete reply has been made to the outstanding Office Action and, as such, the present application is in condition for allowance. If the Office believes, for any reason, that personal communication will expedite prosecution of this application, the Office is invited to telephone the undersigned at the number provided.

Prompt and favorable consideration of this Amendment and Reply is respectfully requested.

Respectfully submitted,

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